

## **REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,828,374 to Coleman et al. ("*Coleman*") in view of U.S. Patent No. 6,829,615 to Schirmer et al. ("*Schirmer*") and U.S. Patent No. 5,714,971 to Shalit et al. ("*Shalit*") and U.S. Patent No. 5,761,610 to Sorensen et al. ("*Sorensen*").

### **I. The Rejection of Claims 1, 2, 4-9, and 11-15 Under 35 U.S.C. § 103(a)**

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . . The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 2, 4-9, and 11-15 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 1 recites a method including a computer program product comprising instructions operable to cause a data processing apparatus to “receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user.” The cited references,

taken alone or in combination, fail to render obvious at least this subject matter of claim 1.

The Examiner concedes that each of *Coleman*, *Schirmer*, and *Shalit* fail to render obvious a “decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user” (Office Action at p. 4). The Examiner, however, relies upon a fourth reference, *Sorensen*, as allegedly disclosing this subject matter of claim 1 (Office Action at p. 4).

*Sorensen* discloses a radio communication device menu system with both a short menu and an extended menu (*Sorensen*, abstract). *Sorensen*’s device includes a menu key 116 that allows a user to go to either the extended menu or the short menu (*Sorensen*, col. 3, lines 50-61). The Examiner relies upon *Sorensen*’s menu key as corresponding to the claimed key (Office Action at p. 4). However, the claimed key establishes a “decoupled mode when [the] key is pressed and held” and a “normal mode when the key is released.” *Sorensen*’s menu key cannot correspond to the claimed key for at least two reasons.

First, even assuming *Sorensen*’s extended menu and short menu could correspond to the claimed decoupled and normal modes, *Sorensen* discloses entering either the extended or short menu based on the duration that the menu key is depressed (See *Sorensen* col. 3, lines 51-61). Specifically, *Sorensen* discloses that if the menu key is held for greater than a time threshold T1, the extended menu is displayed, and if the period of time does not exceed the threshold, the menu stays in short menu operation (*Sorensen*, col. 3, lines 51-61). Thus, in *Sorensen*, both the short

menu or extended menu “modes” are established by releasing the key. In contrast, the claimed decoupled mode is established “when the key is pressed and held” and the normal mode established “when the key is released.”

Second, even assuming one of *Sorensen*’s extended/short menu options could be characterized as a “normal” mode, neither menu can reasonably be characterized as “decoupled.” Indeed, in the claimed “decoupled” mode, “navigation to an independent element does not change which, if any, of the independent elements is the selected element.” *Sorensen* in no way suggests that either the short or extended menus “decouples” the menu or any other part of *Sorensen*’s interface.

Further, the proposed combination of *Coleman* and *Sorensen* is improper. M.P.E.P. § 2143.01(VI) states that if “the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious *In re Ratti*, 270 F.2d 810 (CCPA 1959).” Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a), because the Examiner’s proposed combination of *Coleman* with *Sorensen* would change *Coleman*’s principle of operation.

*Coleman* discloses a help index that can be searched using an “alpha scroll bar ” (*Coleman*, Fig. 8, and col. 10, line 51 to col. 11, line 14). Letters on the alpha scroll bar can be selected by a number of methods, including “placing [a] cursor over a portion of slider 175, depressing [mouse] switch 46 and dragging the cursor and slider over the desired letter ... [and] releas[ing] [mouse] switch 46,” (*Coleman*, col. 11, lines 20-23).

When a letter in the alpha scroll bar is selected, help index entries beginning with the selected letter are displayed (*Coleman*, col. 11, lines 64-66).

The Examiner relies on *Coleman*'s letters on the alpha scroll bar as corresponding to the claimed "independent elements" and *Coleman*'s help index entries as corresponding to the claimed dependent elements (Office Action at p. 3). However, the Examiner does not articulate precisely how *Sorensen* could be combined with *Coleman*. In any case either *Coleman*'s mouse button or another input would need to be modified to serve as the key recited in the claimed "receive user input from a user to establish a decoupled mode when a key is pressed and held by the user, and to establish a normal mode when the key is released by the user."

As discussed, *Sorensen*'s disclosure is directed toward holding a key down for a predetermined amount of time in order to view either a short or extended menu. By combining *Sorensen* with *Coleman*, a user would have to hold down either *Coleman*'s mouse switch or another key for different amounts of time depending on which mode the user wishes to establish.

Using *Coleman*'s mouse switch would present problems because *Coleman* already uses the mouse switch to determine that a user intends to select a given letter on the scroll bar. Using the proposed combination with *Coleman*'s mouse switch, the user would have to depress the mouse switch for an extended period of time to establish at least one of the modes. This would disadvantage *Coleman*'s users because they would not be able to immediately release the mouse key to select a letter on the scroll bar.

Using another key in *Coleman* would also present disadvantages to the user. For example, using a key on *Coleman*'s keyboard with *Sorensen*'s timing functionality would require a user to use both the mouse switch and the key at the same time. Further, while this would free the mouse switch to allow a user to immediately select a letter by clicking the mouse switch, the user would still have to wait for the predetermined amount of time after pressing the key to establish at least one of the modes. For at least these reasons, the proposed combination of *Coleman* with *Sorensen* would *Coleman* change *Coleman*'s principle of operation, and therefore the combination is improper.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Further, the proposed combination is improper because the combination of *Coleman* with *Sorensen* would change *Coleman*'s principle of operation. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the cited references. Therefore, a *prima facie* case of obviousness has not been established for claim 1 for at least this reason.

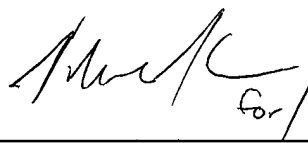
Although of different scope, independent claims 8 and 15 recite features similar to those of claim 1 already discussed. Claims 1, 2, and 4-7 depend from claim 1, and claims 9 and 11-14 depend from claim 8. Therefore, Applicants request that the rejection of the pending claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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